

U.S. Serial No. 09/633,846
Art Unit 1772

Amendment D

Remarks:

Responsive to the Official Action mailed July 14, 2003, Applicant respectfully requests reconsideration, reexamination and allowance of claims 16 and 20-22 in view of the following remarks.

Applicant would like to first thank Examiner Simone for her treatment of the previous paper, which was inadvertently filed as a CPA, as a request for continued examination under 37 CFR 1.114.

The Examiner has rejected claims 16 and 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lupinski et al., U.S. Patent No. 4,100,883. The Examiner has characterized Lupinski as disclosing a corrosion-resistant coated and cured strap comprising an elongated metal strap base element having a width defining first and second sides and a thickness defining a pair of opposing edge regions. The Examiner states further that the strap has a melted and cured powder coating on the base element, the coating having a first substantially consistent thickness at the first and second sides and a second substantially consistent thickness at the edge regions, and that the first and second thicknesses are different from one another. The Examiner further describes Lupinski as disclosing that the coating has a greater thickness at about the pair of opposing edge regions and about regions of the first and second sides adjacent the pair of opposing edge regions than on the first and second sides. The Examiner concedes, however, that Lupinski fails to disclose the coating thickness defining a dog-bone profile.

Moreover, the Examiner states that it is to be expected that a change in shape of the coating thickness would be an unpatentable modification, but that under some circumstances, however, changes such as shape may impart patentability to a product if the particular shape claimed produces a new and unexpected result which is different in kind and not merely in degree from the results of the prior art, citing *In re Dailey et al.*, 149 USPQ 47 (CCPA 1966).

Nevertheless, the Examiner has taken the position that that it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to change the shape of the coating thickness in Lupinski to define a dog-bone profile. The Examiner concludes that "[o]ne skilled in the art would have been motivated to do so [to change the shape of the coating

U.S. Serial No. 09/633,846
Art Unit 1772

Amendment D

thickness in Lupinski to define a dog-bone profile] in order to form a coated metal strap, since it has been held that a change in form or shape of the coating thickness would be an unpatentable modification absence of showing unexpected results.

Admittedly, Lupinski discloses a corrosion-resistant coated and cured element formed from an elongated metal base member having a width that defines first and second sides and a thickness that defines a pair of opposing edge regions, which base member has a melted and cured powder coating having a first substantially consistent thickness at the first and second sides and a second substantially consistent thickness at the edge regions. Further Applicant acknowledges the Examiner's concession regarding the dog-bone profile.

However, Applicant takes issue with the Examiner's contention that one skilled in the art would have been motivated to change the shape of the coating thickness in Lupinski to define a dog-bone profile to form a coated metal strap. Specifically, it is Applicant's position that rather than being motivated by Lupinski to "change the shape" to a dog-bone profile, one would have been disinclined to alter the shape to a dog-bone profile. A careful reading of Lupinski shows that such a shape was undesirable and that one of the reasons for the method of Lupinski was to provide a substantially uniform coating thickness all around the base member.

Referring to Lupinski, col. 6, lines 7-23 provide that:

In coating wire having an elongate cross sectional shape, e.g. cross-sectional length to cross-sectional width ratios of 2:1 or more, it is generally found that, when all the electrodes in array 22 are connected to the high voltage DC generator, *the resulting coatings are nonuniform about the wire perimeter, i.e., the opposite narrow ends of the wire are found to have relatively larger coating thickness. FIG. 4 illustrates such an undesirable result for rectangular wire 74 coated in a coating operation wherein opposite narrow ends 76A and 76B are aligned with diametrically opposed electrodes 22A and 22B respectively, and all the electrodes in array 22 are connected through their corresponding switches to the high voltage D.C. generator. As shown in FIG. 4, the coating 78 includes coating regions 80A and 80B of relatively larger thickness at narrow ends 76A and 76B of the rectangular wire.*

Lupinski, U.S. Patent No. 4,100,883, col. 6, line 7-23 (emphasis added).

Reproduced below is FIG. 4 from Lupinski which, in Applicant's view is more akin to the

U.S. Serial No. 09/633,846
Art Unit 1772

Amendment D

claimed dog-bone profile, and which, according to Lupinski, is an *undesirable* coating configuration.

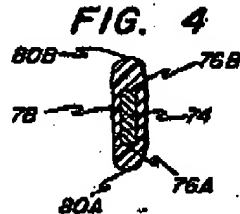
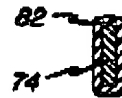


FIG. 5



In viewing this figure, along with the text of col. 6, lines 7-23, and comparing this to FIG. 5, also reproduced above, it is clear that Lupinski teaches away from a coating profile in which the coating is thicker at the ends than at the center portion. And, although Lupinski does not show a "traditional" dog-bone profile, it is submitted that the configuration of FIG. 4 is akin to such and that the teaching of Lupinski away from this profile is equally well applicable and analogous to teaching away from the claimed dog-bone profile.

In summary, it is applicant's position that the Lupinski patent alone or in combination with any of the art of record (including the Winkle and Nagasaka patents previously used as a basis for rejecting the claims, but now deemed moot) does not teach the presently claimed invention. In fact, it is applicant's position that the Lupinski patent would not have made the presently claimed invention obvious because, among other reasons, it clearly teaches away from the claimed invention by striving for a consistent and uniform cross-section and shows as undesirable, a profile similar to a dog-bone profile.

In conclusion, applicant respectfully and earnestly request reconsideration, reexamination and allowance of claims 16 and 20-22 in view of the following amendments and remarks.

Applicant believes that there is no fee due in connection with the present Amendment D. If, however, there is a fee due, Applicant authorizes the Commissioner to charge any underpayment, or credit any overpayment, to Deposit Account No. 23-0920. Should any petitions be necessary, applicant requests that this paper constitute any such necessary petition.

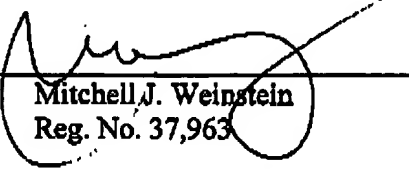
U.S. Serial No. 09/633,846
Art Unit 1772

Amendment D

If the examiner finds that there are any outstanding issues that may be resolved by a telephone interview, the Examiner is invited to contact the undersigned at the below listed number.

Respectfully submitted,

By:


Mitchell J. Weinstein
Reg. No. 37,963

RECEIVED
CENTRAL FAX CENTER
OCT 14 2003

OFFICIAL

October 13, 2003
WELSH & KATZ, LTD.
120 South Riverside Plaza
22nd Floor
Chicago, Illinois 60606
Telephone: (312) 655-1500
Facsimile: (312) 655- 1501